

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Roelvink et al.

Application No. 09/617,569

Filed: July 17, 2000

For: ANTIGENIC COMPOUNDS AND METHODS



Group Art Unit: 1648

Examiner: S. Foley

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RESPONSE TO OFFICE ACTION

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to the Office Action dated December 21, 2000, please consider the following remarks.

Discussion of Office Action

The Office Action sets forth a restriction requirement requiring Applicants to elect one of the following Groups of claims for further prosecution:

- (I) claims 1-32 and 40-43, drawn to a complex and methods of immunizing using the complex (classified in class 424, subclass 196.1), or
- (II) claims 33-39, drawn to a library and methods for assessing antigenicity (classified in class 436, subclass 501).

Discussion of the Restriction Requirement

Applicants elect the claims of Group I for further prosecution; however, the election is made with traverse. There are two separate criteria for a proper requirement for restriction between patentably distinct inventions:

- (i) the inventions must be independent or distinct as claimed,
- and
- (ii) there must be a serious burden on the Examiner if restriction is not required.

CERTIFICATE OF MAILING

I hereby certify that this RESPONSE TO OFFICE ACTION (along with any documents referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Date: January 22, 2001

Reth Phillips

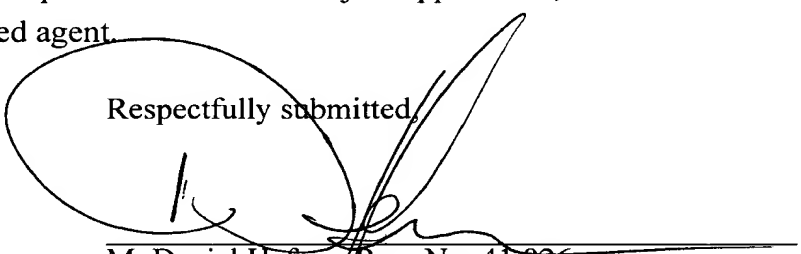
Both of these criteria must exist for a restriction requirement to be proper, and “[I]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions” (M.P.E.P. § 803).

In the case at hand, the Office fails to meet the requisite criteria. For example, three of the claims of Group II (i.e., claims 33, 34, and 38) depend from the Group I claims, and the remaining Group II claims also concern complexes as recited in the Group I claims. Thus, a proper and complete search of Group II must necessarily include the entirety of the search conducted for Group I. As such, a search of the two separate Groups necessarily will include much of the same material, and it is likely that searching the two Groups of claims concurrently actually will be less burdensome than searching them separately (as efforts would have to be duplicated). In any event, if there were any added burden in searching the Groups together, it hardly would be “serious.” As such, the requirement should be withdrawn and the Groups examined together.

Conclusion

Under the circumstances, Applicants request the withdrawal of the restriction requirement, in whole or in part, and consideration of the pending claims in Group II in addition to those of elected Group I. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned agent.

Respectfully submitted,



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Dated: January 22, 2001
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